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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,627	02/18/2004	John C. Reed	66821-276	5834
7590 Cathryn Campbell McDERMOTT, WILL & EMERY 4370 La Jolla Village Drive, Suite 700 San Diego, CA 92122			EXAMINER RAWLINGS, STEPHEN L.	
			ART UNIT 1643	PAPER NUMBER
			MAIL DATE 05/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/782,627	Applicant(s) REED ET AL.
Examiner Stephen L. Rawlings	Art Unit 1643

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 May 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2-5.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☒ Other: See Continuation Sheet; see Notice of Non-Compliant Amendment.

/Stephen L. Rawlings/
Primary Examiner, Art Unit 1643

Continuation of 11. does NOT place the application in condition for allowance because:

The amendment is non-compliant and cannot be entered in part. See the attached Notice of Non-Compliant Amendment for further explanation.

Applicant's request has been carefully considered but the amendment, oath/declaration, terminal disclaimer, and declaration under 37 C.F.R. § 1.132 filed May 12, 2008, fail to place this application in condition for allowance because the amendment is non-compliant and cannot be entered in part, the declaration under § 1.132 has not been found sufficient to overcome the rejection of claims 2-5 under 35 U.S.C. § 102(a) for the reason set forth in section 15 at page 8 of the prior Office action mailed January 4, 2008, and because the terminal disclaimer has not yet been approved by the Office.

With regard to the merit of the declaration under 37 C.F.R. § 1.132 by John C. Reed and Shinichi Takayama, it is noted that Applicant has not provided a showing of good and sufficient reasons as to why the declaration is necessary, but was not presented earlier before prosecution was closed. Nonetheless, were the merit of this declaration considered, it is aptly noted that it states only that authors K. Kochel, S. Irie, J. Inazawa, T. Abe, T. Sato, T. Druck, and K. Huebner worked under the direction and supervision of John C. Reed and Shinichi Takayama, and fails to state that Applicant is the sole inventor of the claimed invention. See M.P.E.P. § 715.01(c): "An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)." Thus, the declaration under 37 C.F.R. § 1.132 by John C. Reed and Shinichi Takayama filed May 12, 2008, has been entered but cannot be considered proper or sufficient to overcome the rejection of claims 2-5 under 35 U.S.C. § 102(a) for the reason set forth in section 15 at page 8 of the prior Office action mailed January 4, 2008.

If entered, the amendment to claim 5 would have overcome the rejection of claim 5 under 35 U.S.C. § 112, first paragraph, for the reason set forth in section 13, beginning at page 7 of the prior Office action mailed January 4, 2008.

Continuation of 13. Other:

The oath/declaration filed May 12, 2008, is objected to because it had not been properly executed by John C. Reed since he failed to date the document on the date it was signed. A new oath/declaration is required in compliance with 37 C.F.R. § 1.67(a).

In addition, receipt of the terminal disclaimer is acknowledged; and a review of the propriety of the terminal disclaimer is pending. Until this review is completed, and the terminal disclaimer is found proper, the Examiner cannot withdraw the rejection of claims 2-5 on the ground of non-statutory obviousness-type double patenting, as set forth in section 11, beginning at page 6 of the prior Office action mailed January 4, 2008.

/Stephen L. Rawlings/
Stephen L. Rawlings, Ph.D.
Primary Examiner, Art Unit 1643